

Docket No. Docket CT-DST-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of SCOUTEN et al

Serial No. 10/036,231

Filed December 24, 2001

)
) Examiner: S.K. Webb
)
) Art Unit: 3731
)

Title: STEREOTAXIC MANIPULATOR WITH RETROFITTED LINEAR SCALES
AND DIGITAL DISPLAY DEVICE

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the
United States Postal Service as first class mail in an envelope
addressed to: MS NON-FEE AMENDMENTS, Commissioner for Patents, P.O. Box
1450, Alexandria, VA 22313-1450, on August 23, 2004.

Name of Registered Representative: Patrick D. Kelly

Signature: Patrick D. Kelly

Date: 23 Aug 2004

ELECTION AND AMENDMENT

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In reply to the Restriction Requirement mailed on June 22,
Applicant hereby elects Species A, including a "dedicated"
display box (as shown in Figure 3), rather than Species B, which
includes a computer and monitor as the display system.

A Petition for a 1-month extension, and an Information
Disclosure Statement, are also enclosed.

The claims are hereby amended, as shown in Attachment A.
These amendments are being made in view of the items discussed in
the Information Disclosure Statement. Briefly, the item shown in
the picture in an advertisement, at the Society for
Neuroscience's Annual Meeting 2000 Exhibit Guide, reads on

certain claims that were originally submitted. However, as described in the text of the application, that system was large, cumbersome, and quite expensive. As a result, very few of those systems were ever sold, and the company that sold them is no longer in business.

When the Applicant company herein developed an enhanced and improved version that (i) was much less expensive, (ii) could be retrofitted to nearly any existing stereotaxic holder, and (iii) took up less bench space, those improved systems became an important commercial success, and are now being sold by several competing companies that adopted a "me-too" approach.

Accordingly, all claims, as amended, now refer and are limited to digitized manipulator devices that can be retrofitted to conventional non-digital stereotaxic holders. That is an important distinction, which represents a crucially important step forward in the art, as indicated by the major impact of that development on actual sales and on the now-widespread adoption and use of that system in most laboratories that do this type of specialized work.

It is also worth noting that the same Applicant company which created this advance in the art has recently created a second major advance in the art, involving systems in which two manipulator arms can be rotated, in controlled and accurately-measured angled and tilted orientations. These systems use specialized custom-written software that automatically calculates (using sine and cosine values) and displays the calculated correct values using the conventional orthogonal scales. That major advance is disclosed and claimed in a separate patent application, serial number 10/636,899, filed on August 6, 2003, assigned to the same Assignee company herein.

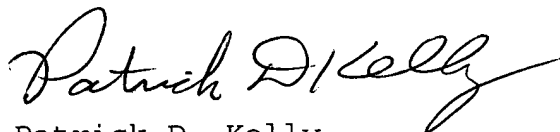
For a number of reasons, that second major advance could not and would not have been created or accomplished, without the foundation and the advance that are described and claimed in this current application. Accordingly, the Examiner is requested to regard that additional factor as a valid "secondary consideration", while analyzing and determining the novelty,

utility, and non-obviousness of the current invention.

Finally, the Examiner is requested to note that in his US patent 6,258,103, Mr. Saracione did not even mention a stand-alone dedicate display device, and instead relied entirely upon a set of three different single-axis readouts, mounted independently on each of his three manipulator arms. Those are shown by callout number 220, 222, and 224 on his Figures 4, and they are described at column 11, lines 33-46 and column 21, lines 45-51 of his patent. If Mr. Saracione knew or even contemplated that a stand-alone display device was the best way to carry out the invention, then he had a binding and unavoidable obligation to at least mention that option, in his '103 patent. However, he apparently did not do so, and apparently did not recognize, when he filed his application, the potential advantages of using a dedicated display unit that could then be "taught" to do new and additional tricks that would lead to entirely different and greatly improved features and capabilities.

In view of the election, amendments, and information disclosure statement, it is believed that the application is ready for substantive examination, and the amended claims are in condition for allowance. The Applicant and attorney await the Examiner's action.

Respectfully submitted,

A handwritten signature in cursive script, reading "Patrick D. Kelly".

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